

Appl. No. 10/756,558
December 27, 2005
Response to Office action of September 30, 2005

REMARKS

In the specification, paragraph [0024] has been amended to correct minor editorial problems.

Claims 1-4, 6, 8-26, 28-47, 49-77 remain in this application. The examiner has acknowledged that claims 65-67 and 69-76 are directed to allowable subject matter. Claims 5, 7, 27, and 48 have been canceled.

I. SPECIFICATION

The examiner objected to the disclosure because of the informality that in first line of paragraph [0024] it appears that "FIGURE 1" should read --FIGURE 2--.

The applicant has amended paragraph [0024] in accordance with the examiner's suggestions.

II. CLAIM REJECTIONS – 35 USC § 112

A. Examiner's Statements

The examiner rejected claims 24, 45, 64, and 68 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Specifically, the examiner stated that "VITON" is a trademark name and renders the claims indefinite because its defined chemical composition is capable of changing over time.

B. Claims

The applicant has amended claims 24, 45, 64, and 68 as described above. The applicant respectfully submits that the claims as amended overcome the examiner's rejection and request that the examiner allow the claims as rewritten.

III. CLAIM REJECTIONS – 35 USC § 102

A. Examiner's Statements

The examiner rejected claims 1, 7, 8, 10, 16, 17, 20, 46, 48, 49, 51, 57, 58, and 60 under 35 U.S.C. § 102(e) as being anticipated by Go Boncan, et al. (U.S. Patent Publication No. US 2003/0033893 A1). The examiner rejected claims 1, 3, 5, 11, 12, 19, 22, 25, 27, 30, 32, 33, 34, 38, 39, 43, 46, 52, 53, and 62 under 35 U.S.C. § 102(b) as being anticipated by Jamth (U.S. Patent No. 5,571,951).

Appl. No. 10/756,558
December 27, 2005
Response to Office action of September 30, 2005

B. Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ The identical invention must be shown in as complete detail as is contained in the ... claim.² To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."³ Thus, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.⁴ In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁵ In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.⁶

C. Claims 1, 7, 8, 10, 16, 17, 20, 46, 48, 49, 51, 57, 58, and 60

Claims 1, 7, 8, 10, 16, 17, 20, 46, 48, 49, 51, 57, 58, and 60 of the present application require a curing vessel comprising a flexible sleeve at least partially inside a test vessel. These claims also require substantially no pressure differential between the inside and the outside of the flexible sleeve being maintained for at least some of the method. Go Boncan, et al., however, teaches using a mold as the curing vessel that does not have a flexible sleeve. Go Boncan, et al. also never teaches maintaining substantially no pressure differential between the inside and the outside of the flexible sleeve at any point during the curing or testing process. Thus, Go Boncan, et al. never discloses a curing vessel comprising a flexible sleeve or maintaining substantially no pressure differential between the inside

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

³ *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

⁴ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

⁵ *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

⁶ *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Appl. No. 10/756,558
December 27, 2005
Response to Office action of September 30, 2005

and the outside of the flexible sleeve as required by these claims. The applicant there respectfully submits that the rejection is unsupported by the art and requests that the examiner withdraw the rejection with respect to claims 1, 7, 8, 10, 16, 17, 20, 46, 48, 49, 51, 57, 58, and 60.

D. Claims 1, 3, 5, 11, 12, 19, 22, 25, 27, 30, 32, 33, 34, 38, 39, 43, 46, 52, 53, and 62

Claims 1, 3, 5, 11, 12, 19, 22, 25, 27, 30, 32, 33, 34, 38, 39, 43, 46, 52, 53, and 62 of the present application require a curing vessel comprising a flexible sleeve as located at least partially inside a test vessel. These claims also require substantially no pressure differential between the inside and the outside of the flexible sleeve being maintained for at least some of the method. Jamth, however, teaches placing the cement inside a hard-walled curing vessel inside a test vessel. The curing vessel does not include a flexible sleeve. The examiner states that Jamth teaches maintaining substantially no pressure differential between the outside and the inside of the curing vessel. However, Jamth instead teaches radially directed channels, 18, 18' extending through the double chamber wall of the test vessel and curing vessel that serve to supply gas to establish an over pressure (differential pressure).⁷ The direct channels 18, 18' extend all the way through the curing vessel wall so that gas may be inserted to create an over pressure or differential pressure directly onto the cement itself rather than onto the outside wall of the curing vessel. Notice that reference numeral 19 shows a filter that distributes this over pressure 360 degrees around the concrete sample and that the filter 19 is inside the curing vessel 6. Therefore, instead of placing pressure on the outside of the curing vessel 6, the channels 18, 18' actually place an overpressure on the inside of the curing vessel 6. Thus, Jamth never discloses a curing vessel comprising a flexible sleeve or maintaining substantially no pressure differential between the inside and the outside of the sleeve at any point in time during the curing or testing process as required by these claims. The applicant therefore respectfully submits that the rejection is unsupported by the art and requests that the examiner withdraw the rejection with respect to the Jamth claims.

IV. CLAIM REJECTIONS - 35 U.S.C. § 103

A. Examiner's Statements

The examiner rejected claims 6, 18, 29, 40, 47, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Jamth.

⁷ Jamth, Column 5, Lines 46-48.

Appl. No. 10/756,558
 December 27, 2005
 Response to Office action of September 30, 2005

B. Law

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.⁸ If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

To establish a *prima facie* case of obviousness, the following tenets of patent law must be adhered to: (a) the claimed invention must be considered as a whole; (b) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (c) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (d) reasonable expectation of success is the standard with which obviousness is determined.⁹ Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.¹⁰

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.¹¹ Thus, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.¹² Additionally, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹³

Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.¹⁴ In addition, if the proposed modification or combination of the prior art would change

⁸ *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

⁹ *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

¹⁰ *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

¹¹ *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

¹² *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *see also In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

¹³ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

¹⁴ *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Appl. No. 10/756,558
December 27, 2005
Response to Office action of September 30, 2005

the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.¹⁵

C. Claim 6, 18, 29, 40, 47, and 59

Claims 6, 18, 29, 40, 47, and 59 depend on underlying base claims 1, 25, and 46, and as such include all of the limitations of the respective underlying, independent claims. The applicant repeats the remarks made above for underlying independent claims 1, 25, and 46 with respect to claims 6, 18, 29, 40, 47, and 59. The applicant submits that the underlying independent base claims 1, 25, and 46 are allowable, and as such these dependent claims are allowable over Jamth as well. Therefore, the applicant respectfully requests that the examiner remove the rejection with respect to dependent claims 6, 18, 29, 40, 47, and 59 as well.

V. AMENDMENTS MADE NOT RELATED TO PATENTABILITY

The applicant has amended claims to more clearly, correctly, and properly claim the invention and not for purposes of patentability. Specifically, the applicant made minor grammatical corrections as well as corrections to maintain claim term consistency. Additionally, other claim amendments made do not affect claim scope in any manner.

These statements are not an admission that the other amendments were made for purposes of patentability, meant to be limiting in any way, or meant to be all-inclusive of amendments not made for purposes of patentability.

VI. ALLOWABLE SUBJECT MATTER

The examiner allowed claims 65-67 and 69-76.

The examiner stated that claims 2, 4, 9, 13-15, 21, 23, 26, 28, 31, 35-37, 41, 42, 44, 50, 54-56, 61, and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant respectfully submits that base claims 1, 25, and 46 are in condition for allowance as discussed above. Therefore, the applicant respectfully requests that the examiner remove the objections to claims 2, 4, 9, 13-15, 21, 23, 26, 28, 31, 35-37, 41, 42, 44, 50, 54-56, 61, and 63.

¹⁵ *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).

Appl. No. 10/756,558
December 27, 2005
Response to Office action of September 30, 2005

The examiner stated the claims 24, 45, 64, and 68 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claims and any intervening claims.

The applicant has amended these claims to overcome the examiner's rejection under 35 U.S.C. § 112, second paragraph, as discussed above. The applicant also respectfully submits that the base claims 1, 25, 46, and 65 are in condition for allowance as discussed above. Therefore, the applicant respectfully requests that the examiner allow claims 24, 45, 64, and 68 without the need to rewrite them to include all of the limitations of the base claims and any intervening claims.

VII. STATEMENT REGARDING CLAIMS

The applicant comments on the allowability of the claims by addressing the examiner's comments in this paper as well as previously during the prosecution of this application. By doing so, the applicant is in no way limiting its ability to argue additional points of novelty regarding the independent claims or dependent claims at a later date.

CONCLUSION

The applicant respectfully requests reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, the applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicant may have amended certain claims, the applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

Appl. No. 10/756,558
December 27, 2005
Response to Office action of September 30, 2005

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-45600) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,
CONLEY ROSE, P.C.



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Page 20 of 20

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